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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,710	10/09/2001	Peggy-Jean P. Flanigan	55526US003	7863

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EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/974,710	FLANIGAN ET AL.	
	Examiner	Art Unit	
	Catherine Simone	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 13 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-17,19-22,25-53 and 55-60 is/are pending in the application.
- 4a) Of the above claim(s) 36-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-17,19-22,25-35,53 and 55-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/13/05 has been entered.

Claim Objections

2. Claim 6 is objected to because of the following informalities: Claim 6 depends from claim 2, which has been cancelled. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "the cap layer" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 56-60 are rejected under 35 U.S.C. 102(a) as being anticipated by Mikami et al. (WO 00/69985).

Mikami et al. discloses an article comprising at least one adhesive layer with a first major surface and a second major surface (Fig. 1, #18), wherein at least one of the first and second major surfaces is a structured surface (Fig. 1, #22), and the structure surface comprises a plurality of discrete reservoirs (Fig. 1, #24), wherein the volume of each is less than about 20 nL (see page 9, lines 28-31). Regarding claim 57, each reservoir has a void volume of less than about 4 nL (see page 9, lines 28-31). Regarding claims 58-60, the reservoirs contain at least one deliverable or non-deliverable substance such as liquids and fluids (see page 3, lines 12-20).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-8, 11, 13, 19-22 and 26-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Abe (WO 99/58620).

Regarding claim 1, Abe discloses an article comprising at least one adhesive layer with a first major surface and a second major surface (Figs. 3, #303), wherein at least one of the first

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and second major surfaces is a structured surface; and a backing (Fig. 3, #301 and/or #302) laminated to the structured surface of the adhesive layer (Fig. 3, #303) wherein the exposed surface of the backing is unstructured, and wherein the article comprises discrete reservoirs between the structured surface of the adhesive layer and the backing (see page 9, lines 30-31).

Regarding claims 3 and 4, note the at least one adhesive layer comprises a pressure sensitive adhesive selected from acrylics and natural rubbers (see page 8, lines 21-23). Regarding claim 5, note the article has a thickness of about 2 μm to about 500 μm (see page 9, lines 8-10).

Regarding claim 6, note the adhesive layer is a structured adhesive layer (Figs. 3 and 4, #303 and #403). Regarding claim 7, note at least one further non-adhesive layer (Fig. 4, #405) in contact with one of the first and second major surfaces. Regarding claim 8, note the article comprises a non-structured exposed surface (Figs. 3 and 4). Regarding claim 11, note a plurality of channels (see page 10, lines 10-15). Regarding claim 13, the channels contain at least one deliverable or non-deliverable substance (see page 10, lines 10-15). Regarding claim 19, note the cap layer is a laminate (Fig. 3, #301 and #302). Regarding claim 20, note the second major surface is a non-structured surface (Fig. 4, #403), the backing (Fig. 4, #401 and/or #402) contacts the first major surface, and wherein the article further comprises a backing layer on the second major surface (Fig. 4, #405). Regarding claim 21, the second major surface is a structured surface (Fig. 4, #403), the backing contacts the first major surface (Fig. 4, #405), and wherein the article further comprises a backing layer on the second major surface (Fig. 4, #401 and/or #402).

Regarding claim 22, Abe discloses a tape comprising at least one pressure sensitive adhesive layer (Fig. 3, #303) comprising a first major surface and a second major surface, wherein the first major surface is a structured surface and the second major surface is a non-

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structured surface; and a non-adhesive backing (Fig. 3, #301 and/or #302) laminated to the first major surface, wherein the tape comprises discrete reservoirs between the structured surface of the adhesive layer and the backing (see page 9, lines 30-31). Regarding claim 26, note further a backing (Fig. 4, #405) adjacent the second major surface (Fig. 4, #403). Regarding claim 27, note the backing is a structured layer (Fig. 3, #302).

Regarding claim 28, note Abe discloses a laminate article comprising a first adhesive layer (Fig. 3, #303) having a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface, and a second adhesive layer (Fig. 3, #302) having a first major surface and second major surface, wherein at least one of the first and second major surfaces is a structured surface, wherein the first adhesive layer and the second adhesive layer are in contact. Regarding claim 29, note the first major surface of the first adhesive layer is a structured surface and the second major surface of the first adhesive layer is a non-structured surface (Fig. 3, #303), and the first major surface of the second adhesive layer is a structured surface and the second major surface of the second adhesive layer is a non-structured surface (Fig. 3, #302), and the second major surface of the first adhesive layer contacts the first major surface of the second adhesive layer. Regarding claim 30, note a backing (Fig. 3, #301) on the second major surface of the second adhesive layer (Fig. 3, #302). Regarding claim 31, note a cap layer (Fig. 4, #405) on the first major surface of the first adhesive layer (Fig. 4, #403). Regarding claim 32, note the first major surface of the first adhesive layer (Fig. 3, #303) contacts the first major surface of the second adhesive layer (Fig. 3, #302). Regarding claim 33, note a backing layer (Fig. 4, #405) on the second major surface of the first adhesive layer (Fig. 4, #403). Regarding claim 34, note the first adhesive layer has a first pattern of structures on the

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first major surface thereof (Fig. 4, #403) and the second adhesive layer has a second pattern of structures on the first major surface thereof (Fig. 4, #402), and wherein the first pattern is substantially aligned with the second pattern. Regarding claim 35, note the first pattern (Fig. 3, #303) is misaligned with the second pattern (Fig. 3, #302).

7. Claims 1, 3-8, 10, 12, 14, 15, 19-22, 25, 26 and 28-35 are rejected under 35

U.S.C. 102(b) as being anticipated by Hata (WO 97/33946).

Regarding claims 1 and 22, Hata discloses a tape comprising at least one pressure sensitive adhesive layer (Fig. 2a, #10 and Fig. 7, #302) comprising a first major surface (Fig. 2a, #2) and a second major surface (Fig. 2a, #5), wherein the first major surface is a structured surface and the second major surface is a non-structured surface; and a non-adhesive backing (Fig. 2a, #3 and Fig. 7, #308) laminated to the first major surface, wherein the tape comprises discrete reservoirs between the structure surface of the adhesive layer and the backing (Fig. 2a, #41). Regarding claims 3 and 4, the adhesive layer is a pressure sensitive adhesive consisting of acrylics (see page 12, lines 13-16). Regarding claim 5, the article has thickness of about 2 μm to about 500 μm (see page 9, lines 1-2). Regarding claim 6, the adhesive layer is a structured adhesive layer (Fig. 2a, #11 and Fig. 7, #302). Regarding claim 7, note at least one non-adhesive layer in contact with one of the first and second major surfaces (Fig. 2b, #6 and Fig. 7, #301). Regarding claim 8, the article comprises a non-structured exposed surface (Fig. 2a, #5 and Fig. 7, #304). Regarding claims 10, 12, 14 and 15, the article comprises a plurality of discrete reservoirs, each reservoir having a void volume of less than 100 μl and contains at least one deliverable or non-deliverable substance (see page 10, lines 30-32 and page 3, lines 6-11). Regarding claim 19, the cap layer is a laminate (Fig. 7, #304 and #305). Regarding claims 20 and

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26, note a backing adjacent the second major surface (Fig. 2b, #6). Regarding claim 21, note the second major surface is a structured surface (Fig. 2b, #10), the backing contacts the first major surface (Fig. 2b, #6), and wherein the article further comprises a backing layer on the second major surface (Fig. 2b, #3). Regarding claim 25, the tape has a peel strength of at least 21-42 oz/0.5 inch for a thickness of 0.003 to 0.007 inches (see page 14, lines 16-20). Regarding claim 28, note a second adhesive layer (Fig. 3a, #13) having a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface, wherein the adhesive layer and the second adhesive layer are in contact (see page 16, lines 24-31). Regarding claim 29, the first major surface of the first adhesive layer is a structured surface and the second major surface of the first adhesive layer is a non-structured surface (Fig. 3a, #10), and the first major surface of the second adhesive layer is a structured surface and the second major surface of the second adhesive layer is a non-structured surface (Fig. 3a, #13), and the second major surface of the first adhesive layer contacts the first major surface of the second adhesive layer. Regarding claim 30, note a backing (Fig. 3a, #6) on the second major surface of the second adhesive layer (Fig. 3a, #13). Regarding claim 31, note a cap layer (Fig. 3a, #3 or #6) on the first major surface of the first adhesive layer (Fig. 3a, #10 or #13). Regarding claim 32, the first major surface of the first adhesive layer (Fig. 3a, #10) contacts the first major surface of the second adhesive layer (Fig. 3a, #13). Regarding claim 33, note further a backing layer on the second major surface of the first adhesive layer (Fig. 3a, #6). Regarding claim 34, the first adhesive layer has a first pattern of structures on the first major surface (Fig. 3a, #10) thereof and the second adhesive layer has a second pattern of structures on the first major surface thereof

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(Fig. 3a, #13), and wherein the first pattern is substantially aligned with the second pattern (Fig. 3a). Regarding claim 35, the first pattern is misaligned with the second pattern (Fig. 3a).

8. Claims 53 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Noreen et al. (US 5,158,557).

Noreen et al. discloses an article comprising at least one first layer with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface (Fig. 12, #14), and a cap layer laminated to a structured surface of the first layer, wherein the cap layer comprises an adhesive and is non-structured on both surfaces (Fig. 12, #26). Regarding claim 55, the first layer comprises a polymeric film (see col. 8, lines 13-40).

9. Claims 1, 3-8, 11, 13 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Tajima et al. (JP 08-100155; refer to computer translation).

Tajima et al. discloses an article comprising at least one adhesive layer (Drawing 1, #1) with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface; and a backing (Drawing 1, #5) laminated to the structured surface of the adhesive layer wherein the exposed surface of the backing is unstructured, and wherein the article comprises discrete reservoirs between the structured surface of the adhesive layer and the backing (see paragraph 0008 and 0009). Regarding claims 3 and 4, the at least one adhesive layer comprises pressure sensitive adhesive such as acrylics (see paragraph 0012, lines 1-4). Regarding claim 5, the article has a thickness of about 2 μm to about 500 μm (see paragraph 0005, lines 5-8). Regarding claim 6, the adhesive layer is a structured adhesive layer (Drawing 1, #1). Regarding claim 7, note at least one non-adhesive layer in contact with one of the first and second major surfaces (Drawing 1, #2). Regarding claim 8, the article comprises a

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non-structured exposed surface (Drawing 1, #5). Regarding claims 11 and 13, note a plurality of channels containing at least one deliverable or non-deliverable substance (Drawing 3, #4).

Regarding claim 21, the second major surface is a structured surface (Drawing 1, #1), the backing (Drawing 1, #5) contacts the first major surface, and wherein the article further comprises a backing layer (Drawing 1, #2) on the second major surface.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 56-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hata (WO 97/33946).

Regarding claims 56 and 57, Hata discloses at least one adhesive layer (Fig. 1b, #10) with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface (Fig. 1b, #12), and the structure surface comprises a plurality of discrete reservoirs (Fig. 1b, #4). However, Hata fails to disclose the volume of each reservoir being less than about 20 nL and having a void volume of less than about 4 nL. Hata teaches the volume of each reservoir being within a range of 0.8 to 600 mm³ (see page 10, lines 30-32). Therefore, the optimum ranges for the volume and void volume of each reservoir would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. Thus, it would have been obvious to one of ordinary skill

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in the art at the time the applicant's invention was made to have modified the reservoirs in the adhesive sheet of Hata to each have a volume of less than about 20 nL and a void volume of less than about 4 nL, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

Regarding claims 58-60, note the reservoirs contain at least one deliverable or non-deliverable substance (see page 3, lines 6-12).

12. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Abe (WO 99/58620) or Tajima et al. (JP 08-100155).

As shown above, Abe and Tajima et al. each disclose an article comprising at least one adhesive layer with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface; and a backing laminated to the structured surface of the adhesive layer wherein the exposed surface of the backing is unstructured, and wherein the article comprises discrete reservoirs between the structured surface of the adhesive layer and the backing. However, each fails to disclose the reservoirs having a void volume of less than 100 μ l. The optimum ranges for the void volume of each reservoir would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the reservoirs in the adhesive sheet of either Abe or Tajima et al. to each have a void volume of less than 100 μ l, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the

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optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

13. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Tajima et al. (JP 08-100155) or Abe (WO 99/58620) in view of Sher et al. (US 6,197,397).

As shown above, Tajima et al. and Abe each disclose an article comprising at least one adhesive layer with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface; and a backing laminated to the structured surface of the adhesive layer wherein the exposed surface of the backing is unstructured and the article comprises a plurality of channels and discrete reservoirs. However, each fails to disclose the channels and reservoirs containing a deliverable or non-deliverable substance being selected from the groups recited in each of claims 16 and 17. Sher et al. teaches that it is old and well-known in the analogous art to have an adhesive provided with channels containing fluids for the purpose of permitting controlled ingress of fluids at a desired time to affect the adhesive interface such as to facilitate removal, alter surface characteristics and provide additional remedial treatments (see col. 5, lines 33-37 and col. 8, lines 55-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the channels and reservoirs in either Tajima et al. or Abe to contain at least one deliverable or non-deliverable substance such as liquids and antibiotics as taught by Sher et al. in order to permit controlled ingress of fluids at a desired time to affect the adhesive interface such as to facilitate removal, alter surface characteristics and provide additional remedial treatments.

Response to Arguments

14. Applicant's arguments filed 9/13/05 have been fully considered but they are not persuasive. Applicant argues that "Hata fails to disclose a backing". However, as shown in the rejection above, Hata clearly teaches a backing as recited in claims 1 and 22. Thus, the claims fail to patentably define over the Hata reference as applied above.

Furthermore, Applicant argues that "nothing in Hata would allow one of skill in the art to know that it was even possible to make smaller volume voids. Additionally, the Examiner must read Hata as a whole. Hata teaches a disadvantage in having volumes less than 1 mm^3 . Such a volume is still in excess of the presently claimed ranges". However, the optimum ranges for the volume of each reservoir would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the reservoirs in the adhesive sheet of Hata to each have a volume of less than about 20 nL and a void volume of less than about 4 nL, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

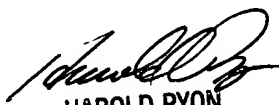
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Catherine A. Simone
Examiner
Art Unit 1772
November 23, 2005



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1112

11/28/05